

Appl. No. 09/629,323
Amdt. dated January 17, 2004
In response to Office Action mailed November 3, 2004

REMARKS/ARGUMENTS

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Preliminary Statement

Applicant notes that the Examiner has withdrawn the grounds of rejection of claims 1, 2, 5, 8, 11-13, 15 and 17-20 after consideration of Applicant's amendments and arguments. Applicant notes that the Examiner withdrew the grounds for rejection of claims 1, 8, 12 and 17 under 35 U.S.C. §101. Finally, Applicant also notes that the Examiner acknowledged Applicant's response to the Rule 105 request for information.

Presentation of Exhibits To Amendment D

Applicant is submitting the exhibits to this response in an Appendix, referred to herein as "App.". For the convenience of the Examiner, the exhibits will be identified throughout the remarks by Appendix exhibit number, the abbreviated title of the exhibit, and a referenced paragraph, where applicable. For example, a reference to the third paragraph of the Supplemental Affidavit of James F. Allsup Under 37 C.F.R. §1.132,

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included in the Appendix as Exhibit 2, will be referred to hereinafter as App. Ex. 2, Supp. Allsup Aff'd, ¶3.

Exhibits attached to the Appendix exhibits will be identified by Appendix exhibit number, the abbreviated title of the appendix exhibit, the letter designation of the exhibit to the Appendix exhibit, the abbreviated title of the exhibit, and paragraph, where applicable. For example, the third paragraph of the Supplemental Declaration of Barry F. Wolfson, which is attached as Exhibit A to the Supplemental Affidavit of James F. Allsup Under 37 C.F.R. §1.132, will be referred to hereinafter as App. Ex. 2, Supp. Allsup. Aff'd., Exhibit A, Supp. Wolfson Decl., ¶3).

The Rejections Under 35 U.S.C. §103

The examiner rejected claims 1, 8, 11-12 and 17-19 as being unpatentable over SSDC in view of Allsup and Richman et al's U.S. Patent No. 6,635,582 ("Richman"). The Examiner also rejected claim 13 as being unpatentable over SSDC, Allsup and Richman and further in view of Examiner's use of official notice. Furthermore, the Examiner rejected claims 5 and 15 as being unpatentable over SSDC, Allsup and Richman and further in view of Examiner's use of Official Notice. Finally, claim 20 was rejected as being unpatentable over SSDC, Allsup and Richman and in further view of Pritchard. Applicant respectfully traverses all of the rejections, for the reasons set forth hereinafter.

The Examiner Did Not Establish *Prima Facia* Obviousness

Applicant respectfully points out, in regards to all of the rejections, that Applicant previously has overcome rejections based upon SSDC, Allsup, Pritchard, and the

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Examiner's assertion of official notice, either alone or in combination. Consequently, the basis of the present rejections is the addition of Richman. Applicant hereby reserves the right to show that Richman is not prior art and that Applicant invented his system before the filing date of the Richman patent.

In any event, and without conceding that Richman is prior art, Applicant respectfully points out Richman, either alone or in combination with the other cited references, which already have been distinguished, does not render the claims of the instant application unpatentable. Applicant respectfully points out that the Examiner has not established *prima facia* obviousness. To establish *prima facia* obviousness all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974), as cited in *The Manual of Patent Examining Procedures* §2143.03 (2001 ed)(emphasis added). In this case, the *prima facia* case fails because the cited references, either alone or in combination, do not teach or suggest all the claim limitations.

The Claims Are Allowable Over SSDC, Allsup, Pritchard and Official Notice

As an initial matter, Applicant already has shown, in a convincing manner, that the independent claims are patentable over SSDC, Allsup and Pritchard, alone or in combination with each other, or in combination with Examiner's use of Official Notice. Those arguments are set out in detail in the Remarks/Arguments and supporting Affidavits and Exhibits of Amendment A, submitted February 28, 2003, and in the Remarks/Arguments and supporting Affidavits and Exhibits of Amendment B, filed February 27, 2004. The Remarks/Arguments, Affidavits and Exhibits submitted in

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Amendments A and B are hereby incorporated herein by reference. However, to be fully responsive to the latest rejections, and for the convenience of the Examiner, Applicant will repeat, in a succinct manner, relevant arguments made in both Amendment A and Amendment B.

In regards to the rejection of claims 1, 8, 11-12 and 17-19 as being unpatentable over SSDC in view of Allsup and Richman, Applicant points out that the independent claims are allowable over SSDC and Allsup for the reasons previously found persuasive in the Remarks/Arguments, Affidavits and Exhibits submitted in Amendments A and B. Applicant previously has demonstrated by argument and supporting Affidavits that SSDC and Allsup, either alone or in combination, do not teach or show all the steps of the claims.

Applicant notes that the Examiner again is relying on SSDC to support the rejection of the claims, specifically the Examiner cites SSDC for disclosing elements designated as a) through d). Applicant will again point out that SSDC, as well as Allsup, do not teach or suggest such steps to one skilled in the art.

Applicant respectfully points out that SSDC does not teach or suggest any specific procedures, such as establishing direct deposit of SSDI benefits by the SSA, determining a date of direct deposit, determining an amount of overpayment to be recovered, and electronically recovering disability benefits previously provided to the disabled person. These steps, absent from any of the prior art references, are important to the novel method. As Mr. Allsup attested to in his first Affidavit submitted with the first Amendment, it took significant inventive effort on his part to initiate those

efforts to solve a problem long known to the industry. (Affidavit of James F. Allsup Under 37 C.F.R §1.132 ¶¶ 17-28, resubmitted herewith in the Appendix as Exhibit 1, and referred to hereinafter as "App. Ex. 1, First Allsup Aff'd.").

As previously pointed out, all the reference suggests is that SSDC offers as a service "Coordination of overpayment recoveries resulting from SSDIB awards." The dictionary definitions of "Coordination" include 1. the act or state of coordinating or being coordinated. RANDOM HOUSE WEBSTER' S UNABRIDGED DICTIONARY (2nd Ed. 1998). At the very most, SSDC suggests that it may be involved in some vague act of coordinating an overpayment recovery after an SSDIB award. This limited teaching in SSDC comports with the inventor's understanding of the services offered by SSDC around the date of the reference. Referring to Paragraphs 8 and 9 of App. Ex. 1, First Allsup Aff'd., Mr. Allsup describes this activity as a "back-end" approach that was fraught with numerous problems that his invention has solved.

Although it is the PTO's position that a reference cited under section 103 does not have to be "enabling" (MPEP §2121.02.II) a full reading of the case law cited in the Manual provides that a non-enabling reference "may qualify as prior art reference under §103, but only for what is disclosed in it." *Symbol Technologies, Inc. v. Opticon*, 935 F.2d 1569, 1578 (Fed. Cir. 1991) (emphasis added)(quoting *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984)). Applicant reiterates that the reference does not disclose any method for recovering overpayments and, as set out above, merely suggests that SSDC may have provided a coordination service related to overpayment recoveries.

The SSDC brochure fails as a reference under section 103 because it does not teach or suggest any means to allow the inventor to arrive at his method. *Minnesota Mining and Manufacturing v. Blume*, 215 USPQ 585, 590 n. 10 (6th Cir. 1982). As more specifically pointed out in the Supplemental Affidavit of James F. Allsup Under 37 C.F.R. §1.132, ¶19, resubmitted in the Appendix as Exhibit 2 (referred to hereinafter as "App. Ex. 2, Supp. Allsup Aff'd."), the reference does not teach or suggest any means to arrive at the steps of the claimed overpayment recovery method. Mr. Allsup points out that it took him six years after becoming aware of the brochure to develop a commercial embodiment of this novel process (App. Ex. 2, Supp. Allsup. Aff'd. ¶20). The SSDC reference teaches or suggests nothing that would lead to the instant invention.

Another person skilled in the art, Mr. Barry Wolfson, shares Mr. Allsup's opinion. The Supplemental Declaration of Barry Wolfson is resubmitted as Exhibit B to the App. Ex. 2, Supp. Allsup Aff'd, and is referred to hereinafter as the "App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl." Mr. Wolfson was employed by Aetna from 1965 to the end of 2002. In 1983 Mr. Wolfson started Aetna's Social Security Advocacy Program, which hired skilled Social Security representatives to assist long-term disability claimants in obtaining Social Security Benefits. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶6).

Mr. Wolfson can be considered one of ordinary skill in the relevant art. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶7). Mr. Wolfson has reviewed the SSDC brochure cited by the Examiner and is familiar with SSDC and the services

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SSDC offered around 1993. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 8). From the early 1990s until 2002, Aetna was the insurance carrier for the State of Michigan, providing long-term disability benefits and claims services. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 9). At the same time, SSDC was retained by the State of Michigan to obtain benefits for its employees from the Social Security Administration. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 10). Through his access to records and statistics, Mr. Wolfson was aware of the fact that the State of Michigan had a significant problem with recovering overpaid benefits from the insured after an award of SSDI. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 11).

To the best of his knowledge, Mr. Wolfson does not think SSDC was engaged in any system for recovering overpaid benefits. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 12). It is Mr. Wolfson's belief that if SSDC had or knew of any type of method to recover overpaid disability benefits in the early 1990s, it would have marketed that product to the State of Michigan in response to its significant problem in recovering overpaid benefits. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 13). It is Mr. Wolfson's opinion that if the SSDC brochure had indicated or suggested that such a service was available, one knowledgeable about LTD claim practices would have requested SSDC to develop such a program to respond to the needs of the State of Michigan. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., 13).

It also is Mr. Wolfson's opinion that the SSDC brochure does not indicate or suggest to one who is knowledgeable about LTD practices any method or system for recovering overpaid benefits and that it certainly does not indicate that there is an electronic overpayment recovery service or any program that includes all the complex steps that were developed in the inventor's system. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶14). According to Mr. Wolfson the quote "Coordination of overpayment recoveries resulting from SSDIB awards" contained in the SSDC brochure does not suggest any method of recovering overpayments and, in fact, he finds the statement to be vague and unclear as to what the statement was intended to mean or if SSDC was offering any service. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 15).

To the best of Mr. Wolfson's knowledge, SSDC's only participation in the recovery of overpayments was to emphasize to the claimant his or her obligation to repay the overpaid benefit to the carrier, and SSDC took no active role in a recovery. Mr. Wolfson believes the statement "Coordination of overpayment recoveries resulting from SSDIB awards" refers to that limited activity. (App. Ex. 2, Supp. Allsup Aff'd., Ex. B, Supp. Wolfson Decl., ¶ 16). Mr. Wolfson's statements confirm Mr. Allsup's understanding of SSDC's business, as set out in paragraph 9 of App. Ex. 1, First Allsup Aff'd.

The Examiner again cites the brochure produced by the inventor's company entitled *Allsup, Inc.'s Overpayment Recovery Service* to support the claim rejections. This brochure describes the inventor's old manual system whereunder the claimant is

informed that he or she is obligated to repay any overpayments, provided the total overpaid amount, and then the claimant signs and sends a check to Allsup for that amount less a percentage savings for using the system. As pointed out in the App. Ex. 2, Supp. Allsup Aff'd., although the manual process was an improvement over the "back-end" system, it still suffered from the major drawback of allowing the claimant to get possession of the overpayment and spend it or refuse to issue the check. (App. Ex. 2, Supp. Allsup Aff'd. ¶12)

Because the Allsup brochure disclosed a system that the inventor was trying to replace, it certainly does not render obvious the claimed invention. (App. Ex. 2, Supp. Allsup Aff'd. ¶13). That system did not, and could not, suggest the specific critical steps of obtaining preauthorization from the disabled individual for a direct recovery of the overpaid benefits from a deposit account, after a direct deposit of an SSDI award into the deposit account, establishing the direct deposit of an SSDI benefit into the deposit account by the SSA, or electronically recovering from the deposit account a preauthorized, predetermined amount of long-term disability benefits, immediately after the deposit of SSDI by SSA and the disabled individual's receipt of SSDI payments.

The inventor's company did not implement a commercial embodiment of his new invention until late 1999. The processes of that invention were not obvious in view of the Allsup brochure, and it continued to take him nearly four years after the publication of that particular brochure to develop a commercially successful electronic system of recovery. (App. Ex. 2, Supp. Allsup Aff'd. ¶14).

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Applicant respectfully points out to the Examiner that Mr. Wolfson opined that if any Social Security vendor's brochure or marketing indicated that an automated recovery process or service existed, that system would have been developed before the claimed invention. (App. Ex. 2, Supp. Allsup Aff'd Supp., Ex. B., Supp. Wolfson Decl. ¶21). Applicant points out that Mr. Wolfson's statement includes the contents of *Allsup, Inc.'s Overpayment Recovery Service*, as well.

The Claims Are Allowable In View Of Richman

Even if Allsup and SSDC did teach elements a) through d), as enumerated by the Examiner, they do not explicitly disclose obtaining from the disabled individual pre-authorization for direct electronic recovery of the overpaid benefits from a deposit account, as the Examiner admits. Applicant respectfully points out that Richman, if it was prior art, does not teach or suggest that step either, as set out below, and, therefore, the combination of the cited references fails to make a *prima facie* case of obviousness for the independent claims.

At Page 4 of the Detailed Action, the Examiner states, “[a]lthough Richman is not directed to awards of SSDI, the same method steps for direct recovery of obligations from a deposit account are disclosed by Richman.” Applicant respectfully points out that Richman does not disclose direct recovery of obligations from a deposit account, and, consequently, the Examiner’s rejections relying on Richman, are based on an incorrect premise. It is very important to note that nowhere in Richman is direct electronic recovery or capture by use of a computer of an overpaid disability benefit from a deposit account taught or suggested. (See, Third Affidavit of James F. Allsup

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Under 37 C.F.R. §1.132, ¶12, included in the Appendix as Exhibit 3 and referred to hereinafter as “App. Ex. 3, Third Allsup Aff’d.) Richman, in fact, teaches away from the invention, as will be shown.

First, the Examiner admits that Richman is not directed to awards of SSDI, which is required by the claims. Richman is directed to the use of retirement funds. This distinction is important. (App. Ex. 3, Third Allsup Aff’d., ¶7). For example, the SSA recognizes SSDI and retirement benefits as totally different benefits. (App. Ex. 3, Third Allsup Aff’d., ¶8). Evidence of this lies in the fact that SSDI benefits stop when SSA retirement benefits begin. (App. Ex. 3, Third Allsup Aff’d., ¶8).

One skilled in the art simply would not look to the teachings of a system employing retirement benefits when contemplating a method of recovering overpaid disability benefits. (App. Ex. 3, Third Allsup Aff’d., ¶9). The present invention is directed to the recovery of an overpayment of disability benefits from a retroactive award of SSDI, once it is obtained. (App. Ex. 3, Third Allsup Aff’d., ¶13). The Richman system is directed to the use of disbursements out of prospective deposits of an already established retirement benefit. (App. Ex. 3, Third Allsup Aff’d., ¶13). In fact, Richman’s claims specifically include the elements, “future retirement benefit and “future payments of Social Security retirement benefits”. (See, e.g. col. 8, line 61; col. 9, line 52; col. 10, line 42; col. 11, line 28; col. 11, line 63; col. 12, line 57; col. 13., line 2, 6; col. 13, line 47, 57; col. 14., line 31, 33). And, the Examiner has to assume that Richman’s claims are directed to the subject matter Richman regards as his invention. (See, 35 U.S.C. §112, ¶2). Clearly, Richman did not disclose, and therefore could not claim, any

broader concepts. Consequently, one skilled in the art, considering Richman at the time the invention was made, would not look to the reference when developing a method of recovering overpaid disability benefits.

To the best of the Applicant's knowledge, as one skilled in the art, retroactive awards of an SSA retirement benefit only occur under extraordinary circumstances. (App. Ex. 3, Third Allsup Aff'd., ¶10). One skilled in the art would not look to a plan that is directed to a payment out of a prospective retirement benefit to develop a method of recovering an overpaid disability benefit from a retroactive award of SSDI. (App. Ex. 3, Third Allsup Aff'd., ¶11). Hence, Richman teaches away from the present invention.

The Examiner points to col. 2, lines 30-35 and col. 3, lines 13-54 of Richman as support for the rejection. This section of the specification describes a multi-party arrangement that requires one of the parties, i.e. the participating bank, to make a disbursement from an account, after a direct deposit. It should be appreciated that "recover" or "recovery" and "disburse" and "disbursement" have totally different meanings. (App. Ex. 3, Third Allsup Aff'd., ¶14). Disbursement clearly is a term of art, understood by one skilled in the art reading Richman as requiring the financial institution housing the deposit account to pay out money. (App. Ex. 3, Third Allsup Aff'd. ¶14).

By contrast, the claims of the instant application call for directly recovering from the deposit account a predetermined amount of overpaid benefits previously provided to the disabled person. Disbursing funds from an account and directly recovering funds from an account are totally different concepts. (App. Ex. 3, Third Allsup Aff'd., ¶14). The financial institution described in Richman does not recover funds from the deposit

account; it already is in possession of the funds in the deposit account. It pays out of the deposit account. (App. Ex. 3, Third Allsup Aff'd., ¶15). One skilled in the art considering Richman would be led down the path to developing a scheme of disbursement out of a deposit account by the financial institution, not a method for direct electronic recovery from a deposit account by a Service Provider. (App. Ex. 3, Third Allsup Aff'd. ¶15).

Furthermore, in the instant invention, a Service Provider, for example Applicant's company, obtains preauthorization from the disabled individual to access the deposit account and make a recovery. (App. Ex. 3, Third Allsup Aff'd. ¶16). In Richman, the bank, which houses and generally controls the account pursuant to a contractual arrangement, disburses funds from the account according to a contractual obligation. (App. Ex. 3, Third Allsup Aff'd. ¶16). Again, these steps are conceptually, and practically, quite different, when considered by one skilled in the art. (App. Ex. 3, Third Allsup Aff'd. ¶16). For example, beginning at col. 3, line 13, Richman describes a system that comprises a multi-party agreement among the beneficiary of a retirement fund, a funding source, or asset or service provider, and a financial institution designated to act as both a direct depository and a disbursement agent for transferring funds from the deposit account to the funding source or asset provider. No such multi-party contract exists in, or is required by, the instant invention. (App. Ex. 3, Third Allsup Aff'd. ¶17).

The claimed invention provides for the establishment of direct deposit of SSDI to a deposit account. However, the institution housing the deposit account is under no

specific contractual obligation to disburse funds from the account, which is significant. (App. Ex. 3, Third Allsup Aff'd. ¶18). It is the Applicant's opinion, as one skilled in the art, that under the Richman plan, the beneficiary would be required to set up a deposit account, specific to the contemplated transactions, at a designated financial institution that has expressly agreed to be a contractual party to, and to actively participate in, the transactions. (App. Ex. 3, Third Allsup Aff'd. ¶19). Under the Applicant's method, any acceptable account (i.e. an account over which the disabled individual has control), established or maintained by the disabled individual at any financial institution, can be used. The financial institution does not have to expressly agree to be a contractual party to, or to actively participate in, the transactions. (App. Ex. 3, Third Allsup Aff'd. ¶19). As the Applicant noted in paragraph 25 of App. Ex. 1, First Allsup Aff'd., the determination that ACH transactions could utilize any acceptable account at any financial institution was an important developmental step in the present invention.

Furthermore, Richman teaches the use of a disbursement from a deposit account to pay for a financial service or product, the valuation of which is based upon a determination of the present value of future retirement benefits. (col. 3, lines 38-45) (App. Ex. 3, Third Allsup Aff'd. ¶20). Richman provides a system that requires a payment out of a funded account. (App. Ex. 3, Third Allsup Aff'd. ¶20). The invention embodied in the independent claims of the instant application, by contrast, provides a recovery of a preauthorized, predetermined amount of overpaid benefits, the value of which is certain, based upon an overpaid benefit previously provided by a third party, and not predicated on actuarial or other means of determining the present value of a

future asset, which may or may not be accurate. (App. Ex. 3, Third Allsup Aff'd. ¶21).

The amount to be recovered can be determined by the third party or the service provider. (App. Ex. 3, Third Allsup Aff'd. ¶21). Under the present invention, the disabled individual can preauthorize an electronic recovery of a previously received asset of known value, i.e. a disability benefit previously paid by the third party. (App. Ex. 3, Third Allsup Aff'd. ¶22).

Richman teaches away from the present invention for other reasons. As can be appreciated by one skilled in the art, Richman teaches a complex scheme requiring the contractual obligations between the beneficiary of retirement benefits, a designated, contractually bound financial institution, and a financial service or asset provider, as well as sophisticated actuarial or valuation procedures. (App. Ex. 3, Third Allsup Aff'd. ¶23). Richman's method is a way to raise cash or to acquire an asset or service now, based upon an already established future entitlement, and thus provides significant financial incentives to the individual to cooperate fully. (App. Ex. 3, Third Allsup Aff'd. ¶23). The present invention is a method of recovering previously paid disability benefits for an LTD carrier or self-insured employer, who the disabled individual likely perceives to be an adversary. (App. Ex. 3, Third Allsup Aff'd. ¶24).

Contrary to Richman, the disabled individual under Applicant's invention, has little or no economic incentive to participate. (App. Ex. 3, Third Allsup Aff'd. ¶24). That is, the individual does not receive a new asset or service in exchange for the swept money. (App. Ex. 3, Third Allsup Aff'd. ¶24). The only incentive to the individual to participate in the Applicant's system is to obtain assistance in filing an SSDI claim and

securing SSDI benefits, as well as honoring his or her obligation to return any overpaid benefits to a private carrier or self-insured employer. (App. Ex. 3, Third Allsup Aff'd. ¶25).

The Richman program may be acceptable for a retired individual accustomed to money management or investment techniques who is seeking to cash in on the present value of a future benefit. (App. Ex. 3, Third Allsup Aff'd. ¶26). However, this complex scheme is not appropriate for assisting a disabled individual in paying back overpaid disability benefits after the receipt of retroactive SSDI benefits. One skilled in the art, considering Richman, would find it to be too complex. (App. Ex. 3, Third Allsup Aff'd. ¶26). The inventor's method and the Richman scheme have non-analogous goals. (App. Ex. 3, Third Allsup Aff'd. ¶26).

The invention, as a whole is not restricted to the specific subject matter claimed, but also embraces the problem that it solves. *In re Wright*, 6 USPQ2d 1959, 1961 (Fed.Cir. 1988). Lack of recognition of a problem by a prior art reference is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomiya et al*, 184 USPQ 607, 612-613 (CCPA 1975). Richman does not address the problems Applicant was seeking to solve. (App. Ex. 3, Third Allsup Aff'd. ¶27). One of Applicant's major goals is to effect a swift and efficient direct recovery of an overpaid disability benefit from a deposit account before the disabled person takes mental ownership of the money he or she is obligated to pay back. (App. Ex. 3, Third Allsup Aff'd. ¶28). The method needs to be straight forward enough to encourage participation and effect the recovery quickly and accurately upon deposit of the retroactive SSDI benefit, as determined by the DRD.

(App. Ex. 3, Third Allsup Aff'd. ¶29). In other words, Applicant's system is smooth and seamless. (App. Ex. 3, Third Allsup Aff'd. ¶29).

Hence, to solve the problems known in the art, the amount to be recovered must be readily determined so that the disabled individual can provide preauthorization for the electronic sweep of a sum certain upon direct deposit on a predetermined date.

(App. Ex. 3, Third Allsup Aff'd. ¶30). Applicant's invention solves this problem because the amount is based upon a previously paid benefit and not on speculative determinations of present values of future benefits. (App. Ex. 3, Third Allsup Aff'd. ¶30).

Applicant's invention also is successful in solving the problems recognized in the art because, as noted earlier, it does not require a contract with a financial institution.

(App. Ex. 3, Third Allsup Aff'd. ¶31). It provides for a direct electronic recovery of the overpaid amount and does not rely on contracted disbursements of funds by the financial institution. (App. Ex. 3, Third Allsup Aff'd. ¶31). One skilled in the art, looking at Richman's complex scheme of contractual obligations and disbursements, would be led away from Applicant's simple, yet highly effective method of effecting a recovery before the disabled individual takes mental ownership of the deposited SSDI. (App. Ex. 3, Third Allsup Aff'd. ¶32).

Even if Richman were prior art, Applicant would not have been motivated to combine the teachings of Richman with either SSDC or Allsup or both. "Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). See also, *In re Oetiker*, 977 F.2s 1443, 1447 (Fed. Cir. 1992) ("[t]here

must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination"). In relying on Richman under §103, the Examiner is required to look at the teachings of the entire reference. *In re Wesselau*, 147 USPQ 391, 393 (CCPA 1965) ("it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

Richman, in its entirety, fairly suggests a system that requires a payment out of a funded account for a prescribed period of time selected by the participant. As set out above, Richman, as a whole, teaches a method for providing a present financial product or service and paying for that product or service out of an account that is funded by an already established, subsequently paid retirement benefit. It is an important distinction that Richman teaches a financial incentive to the individual to participate in the program.

Furthermore, Richman, when considered in its entirety, teaches a three-way contractual arrangement with one party being a financial institution. The financial institution is required to make ongoing monthly payments to the product provider after the deposit of regular retirement benefits in a deposit account housed by the financial institution. Richman does not effect a swift and accurate direct electronic recovery of a predetermined amount of overpaid disability benefits from a deposit account held by an individual who has little or no financial incentive to participate the program. Consequently, there was no motivation for the inventor to look to Richman at the time the instant invention was made. *Ted Air, Inc. v. Denso Manufacturing Michigan Inc.* 192

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F.3d 1353 (Fed. Cir. 1999) ("There is no suggestion to combine...if a reference teaches away from its combination with another source . . .").

Applicant also points out that Section 103 specifies that the obviousness of an invention is determined as of "the time the invention was made". It is evident from the foregoing discussion of the teachings of the cited references that the Allsup and SSDC brochures along with the Richman, if it was prior art, would not render the methods of the present invention obvious at the time the invention was made. Applicant respectfully suggests that the Examiner is engaging in an improper use of hindsight in determining obviousness of the instant invention. *Crown Operations International Ltd. V. Solutia, Inc.* 289 F.3d 1367, 1376 (Fed. Cir. 2002) ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.").

In addition to the reasons set out above, the Examiner has failed to make a *prima facie* case of obviousness specifically regarding claim 8. For example, none of the references teach or suggest a method for improving the rate of recovery and decreasing collection time from a claimant of an overpaid disability insurance benefit, which is the recited subject matter of claim 8.

Likewise, for additional reasons, the Examiner has failed to make a *prima facie* case of obvious of claim 11. The references fail to disclose a computer processor or computer software configured to perform data processing functions including determining if the disabled individual qualifies to receive SSDI from the SSA, filing a claim with the SSA on behalf of the disabled individual, monitoring the progress of the

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claim for SSDI and receipt of an award of SSDI from the SSA; calculating an overpaid amount of long-term disability insurance benefits for which the disabled individual has authorized withdrawal prior to receiving a SSDI award; and recovering from a deposit account approved by the SSA for direct deposit of SSDI benefits the calculated overpaid amount of long-term disability benefits previously provided to the disabled person by a third party, after the award of SSDI by SSA and receipt of SSDI payments. Hence, claims 8 and 11 are allowable for numerous reasons.

There also are additional reasons why the Examiner has failed to establish the *prima facie* of obviousness of claim 12. For example, the references cited by the Examiner do not show the step of determining a date of the direct transfer of SSDI from the SSA to the deposit account as provided by claim 12. Richman, by contrast, does not teach or suggest such a step because Richman provides for an ongoing payment out of a regular monthly deposit, the timing of which is not critical. In Richman, there is no need to time the deposit because there is no concern about the individual taking mental ownership of the funds. Consequently, for this and all the reasons set forth above, claim 12 is allowable.

In regards to the specific rejections of claims 5, 13 and 15, it is pointed out that claim 5 depends from claim 1 and claims 13 and 15 depend from claim 12. *The Manual of Patent Examining Procedure* at § 2143.03 states, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)." Because independent

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claims 1 and 12 are allowable over the art of record, Applicant submits that under the applicable law, claims 5, 13 and 15 also are allowable.

Furthermore, the Examiner admits that the references do not explicitly disclose deducting applicable fees or providing ancillary services. Adding Official Notice to the mix does not make up for the deficiencies of the other references. Deficiencies of the cited references cannot be remedied by generalizations as to what is basic knowledge. See, *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). As with any combination of references, in this case Official Notice being substituted for a documented reference, there must be some motivation to combine the references. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). As set out above, there was no motivation to combine SSDC, Allsup and Richman. Clearly there is no motivation to add any teaching from the coin counting machines, credit card services, or the income tax art. Applicant respectfully points out that by resorting to official notice, the rejection again appears to be based upon an impermissible hindsight analysis. *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). Hence claims 5, 13 and 15 are allowable.

In regards to claim 20, Applicant points out that SSDC, Allsup and Richman do not teach salient elements of the claimed invention. For example, the combination, and specifically Richman, does not disclose a computer configured with application programs embodied on a computer readable medium used to effectuate a pre-approved recovery of a predetermined amount of overpaid benefit. The Examiner admits as much. Pritchard does not remedy the deficiencies in the references. In summary, Pritchard is not relevant to the invention of claim 20, particularly as amended. As

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convincingly set out in detail in earlier Remarks/Arguments, Pritchard discloses a system for coordinating medical benefits and is not related to, and consequently cannot suggest, a system for recovering overpaid disability insurance benefits.

The sections of Pritchard relied on by the Examiner are not on point and do not fairly represent the overall teachings of the reference. For example, col. 1, lines 59-66 refer to fee tables, which have nothing to do with the instant invention. Likewise, col. 7, lines 40-46 mentions filling out a standardized claim form, e.g. HCFA 1500. These isolated references to a governmental form and to fee tables, even when combined with the limited teachings of the SSDC, Allsup and Richman, clearly do not suggest each and every element of the method of claim 20. Therefore, the claim is allowable over the combination of references.

Objective Evidence of Non-obviousness

Although Applicant submits that all the steps of his claimed invention are not taught or suggested by the cited references, alternatively, Applicant submits that the object evidence of non-obviousness previously submitted, and updated and submitted herewith, shows that the claimed invention is successful because it solves problems known to the art and, therefore, is not obvious and is patentable over the art. The Examiner is required to consider such objective evidence of non-obviousness. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed.Cir.1983). These objective considerations include long-felt but unsolved need, commercial success, and copying. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 663 (Fed.Cir. 2000). Additional objective considerations include evidence of market share, growth in market share, and

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replacement of earlier products. *Ex Parte Anderson*, App. No. 90-2106, 1991 WL 330661 at*23 (Bd.Pat.App. & Int. 1991).

Applicant previously presented such objective evidence through the original App. Ex. 1, First Allsup. Aff'd. and App. Ex. 2, Supp. Allsup Aff'd., as well as their supporting declarations. The evidence previously presented reflects the commercial success of the claimed invention from 1999 through 2003. Applicant submits updated objective evidence of non-obviousness in the App. Ex. 3, Third Allsup Aff'd. The evidence submitted shows that the claimed method has continued a phenomenal rate of growth over the twelve months of 2004. The inventor's novel system continues to enjoy substantial commercial success, directly related to its ability to increase the overall amounts of recovered overpayments and reduce the time for recovery. (App. Ex. 3, Third Allsup Aff'd., ¶33).

In general, there always was a need for ways to recover disability insurance overpayments. There was the recognized problem that overpayment recovery rates were low. (App. Ex. 1, First Allsup Aff'd. ¶10). There also was the problem of the recipient taking "mental ownership" of the retroactive SSDI payment and spending the money rather than returning the overpayment to his or her private insurer. (App. Ex. 1, First Allsup Aff'd. ¶11).

The inventor's method met a long felt need in the industry to increase the percentage of dollars recovered and decrease the time required to recover. The claimed process practiced by the inventor's company increased the percentage of dollars recovered. (App. Ex. 1, First Allsup Aff'd. ¶33; App. Ex. 2, Supp. Allsup Aff'd. ¶ 24, ¶27;

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App. Ex. 3, Third Allsup Aff'd., ¶34). The inventor's overpayment recovery service decreased the average number of days to recovery. (App. Ex. 1, First Allsup Aff'd. ¶37; App. Ex. 2, Supp. Allsup Aff'd. ¶ 25; App. Ex. 3, Third Allsup Aff'd., ¶35).

Attached as Exhibit B to App. Ex. 1, First Allsup Aff'd. is the original Declaration of Mr. Barry Wolfson, which is being resubmitted for consideration and referred to hereinafter as "App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl." Mr. Wolfson confirms that there was a long-felt need in the industry for a process of recovering the overpaid amounts after the insured received the SSDI benefit but before the insured disposed of the money. (App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl. ¶ 8). Aetna retained Allsup, Inc. in late 1999 or early 2000 to provide overpayment recovery services. (App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl. ¶ 9). With the claimed system, Aetna realized an increase in dollar amounts collected and a decrease in the time from the award of the SSDI benefit to the recovery of the overpaid amount. (App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl. ¶ 10). In his opinion, the claimed automated overpayment recovery system dramatically improves the ability of private insurance carriers to collect overpaid monies owed to them. (App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl. ¶ 11). Mr. Wolfson believes that the claimed automated overpayment recovery system met a long felt need in the industry for increasing the amount of money recovered and decreasing the time of recovery. (App. Ex. 1, First Allsup Aff'd. Ex. B, First Wolfson Decl. ¶ 12).

In App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl., Mr. Wolfson reaffirms his opinions that there was a long felt need in the industry for a viable method

of recovering overpayments. Mr. Wolfson again confirms the problems associated with recovering overpaid benefits. While some overpaid benefits were entirely repaid, a significant number were only partially repaid or never repaid. (App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl ¶ 17). He emphasizes the need in the industry for a method of recovering overpaid amounts. (App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl. ¶ 18).

Mr. Wolfson confirms that this need is still felt in the industry by those insurance carriers who have not subscribed to the claimed method. For example, in 2002, Mr. Wolfson attended a meeting with the SSA, along with nine or ten of the largest LTD carriers to address the industry-wide problem of non-recovered overpaid benefits. Most of the participants at the meeting were not participating in the Allsup overpayment recovery program at the time. (App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl ¶ 19). It is important for the Examiner to note that since the meeting with the SSA, several of the participants have subscribed to, or are seriously considering, the inventor's program. (App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl. ¶ 20). Since filing the previous Affidavits, Applicant has determined that seven (7) of these participants have engaged Applicant's company, with another showing serious interest. (App. Ex. 3, Third Allsup Aff'd. ¶40).

Mr. Wolfson points out that the fact that the largest LTD carriers in the industry could not develop a satisfactory method of overpayment recovery on their own, points out the novelty and non-obviousness of the invention. App. Ex. 2, Supp Allsup Aff'd. Ex. B, Supp. Wolfson Decl. ¶ 20). See, e.g. *Minnesota Mining & Mfg. Co. v. Johnson &*

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Johnson Orthopeadics, Inc., 976 F.3d 1559, 1574-75 (Fed. Cir. 1992) (crediting

evidence of "attempts and failures of the major players in the . . . field").

Attached as Exhibit A to the App. Ex. 2, Supp. Allsup Aff'd. is the resubmitted Declaration of Mr. Jay Barriss, referred to hereinafter as "App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl.". Mr. Barriss is familiar with the long-term disability insurance industry and has worked in the industry for over 11 years. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 3). He was employed by Aetna Life Insurance Company from December, 1998 to June, 2003. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 4). At Aetna, Mr. Barriss was involved in the preparation of financial statements, product pricing and reserve valuation. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 5). Mr. Barriss was aware of the necessity of recovering overpaid disability benefits from their insured. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 6).

Mr. Barriss confirms the problems associated with recovery of overpayments that existed in the industry prior to the instant invention (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 7), and confirms that there was a long-felt need in the industry for a process of recovering the overpaid amounts after the insured received the SSDI benefit but before the insured disposed of the money. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶¶ 8, 12).

Mr. Barriss became familiar with the claimed invention in December, 1999 when Aetna retained Allsup to provide overpayment recovery services. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 9). Prior to that time, Mr. Barriss knew of no other such service available to the long-term disability insurance industry. (App. Ex. 2, Supp

Allsup Aff'd. Ex. A, Barriss Decl. ¶9) Mr. Barriss corroborates Mr. Wolfson's statement that with the claimed system, Aetna realized an increase in dollar amounts collected and a decrease in the time from the award of the SSDI benefit to the recovery of the overpaid amount. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 10). It is Mr. Barriss's opinion, similar to that of Mr. Wolfson, that the claimed automated overpayment recovery system helped improve Aetna's ability to collect overpaid monies owed to them because it provides for pre-approved electronic recovery of the overpaid amount from a deposit account after the SSA deposits the benefit. (App. Ex. 2, Supp Allsup Aff'd. Ex. A, Barriss Decl. ¶ 11).

Resubmitted for consideration by the Examiner, and attached as Exhibit C to the App. Ex. 2, Supp. Allsup Aff'd., is the Declaration of Mr. Scott Ritchie, referred to hereinafter as "App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl." This declaration also supports the statements in Mr. Allsup's three affidavits, Mr. Barriss's declaration and Mr. Wolfson's two declarations. Mr. Ritchie is familiar with the long-term disability insurance industry and has worked in the industry for over 11 years. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶3). Mr. Ritchie has been employed by Standard Insurance Company since approximately July 1992. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶4). His duties at Standard Insurance Company have included quality assurance, claim auditing, oversight of Social Security policy and procedure programs and benefit/resource team supervision (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶5). During his career at Standard Insurance Company Mr. Ritchie became aware

of the necessity of recovering overpaid disability benefits from their insured. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶6).

Mr. Ritchie has experienced the same problems in the industry that the inventor recognized and solved. It has been Mr. Ritchie's experience that once his company's insured received the SSDI payment, it is challenging for the company to recover the overpaid amount. The insured may be reluctant to repay the money to an insurance company. It has been his experience that the process of pursuing recovery of LTD overpayments required a great deal of communication and follow up on the part of claims handling staff. It is a labor intensive and time consuming process. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶7).

Mr. Ritchie believes there is room for improvement of overpayment collection processes within the long-term disability insurance industry. He points out as an example, that a process such as the claimed invention that comprises recovering the overpaid amounts after the insured receives the retroactive SSDI benefit but before the insured spends the money or simply refuses to repay the overpaid benefits to his or her private insurance carrier is of much value to the insurance industry. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶8).

Mr. Ritchie has been familiar with the inventor's claimed electronic overpayment recovery process since July 2001, when Standard Insurance Company retained Allsup, Inc. to recover overpaid benefits. Prior to that time, he knew of no other such service available to the long-term disability insurance industry. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶9). Once Standard Insurance Company retained Allsup, Inc. to

employ its automated overpayment recovery service, Standard Insurance Company soon realized an increase in dollar amounts recovered and a decrease in time from the award of the SSDI benefit to the recovery of the overpaid amount. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶10).

It is Mr. Ritchie's opinion that the claimed automated overpayment recovery system helped improve his company's ability to recover overpaid monies owed to the company because it provides for pre-approved electronic recovery of the overpaid amount from a deposit account after the SSA deposits a benefit but before the insured can spend the money or decide not to refund the overpaid amount to the insurance carrier. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶11). It also is Mr. Ritchie's opinion that the automated overpayment recovery system of the present invention met a need in the industry for increasing the amount of money recovered and decreasing the time of recovery. (App. Ex. 2, Supp. Allsup Aff'd. Ex. C, Ritchie Decl. ¶12).

Because the claimed method satisfied the long felt need in the industry for an improved method of recovering LTD overpayments, it has been met with tremendous commercial success. The inventor's method has shown continued commercial success, particularly when compared to prior art methods of recovering overpayments. For example, the total dollar amount of recoveries has grown from over \$3 million in 1999 to over \$62 million for the year 2004. (App. Ex. 3, Third Allsup Aff'd., ¶34). It will be noted that the total dollar amount of recoveries for the year 2004 is \$21 million greater than all of 2003, as reported in Applicant's previous affidavit. (App. Ex. 3, Third. Allsup Aff'd. ¶34). Over 99% of the total dollar amount of recoveries made so far in 2004 were

through the claimed electronic system. (App. Ex. 3, Third Allsup Aff'd. ¶37), which substantiates the fact that the claimed method is far superior to that known before and continues to grow.

In 1999, when the majority of the dollars recovered were recovered through a direct pay component, the total recovery was approximately \$3 million. However, when the invention was employed to recover the majority of overpayments, beginning in 2000, there was an increase in dollars recovered of over \$10 million. (App. Ex. 1, First Allsup Aff'd. ¶38; App. Ex. 2, Supp. Allsup Aff'd. ¶27) It is believed, therefore that the instant invention was responsible for this sizable increase in business. The total amount of recoveries made per year from 1999 to 2004 grew by over \$58 million. Presently, approximately 99% of the total dollars recovered are for electronic overpayment recovery system clients. Less than 1% of the recoveries were made for manual method clients. (App. Ex. 3, Third Allsup Aff'd., ¶38).

Although direct pay clients remain a small segment of the client's business, it is significant that, to date, the novel electronic system has replaced the manual system to the point where the manual system is no longer of any significance. Due to its efficiencies and significant improvement in recoveries, the new system has essentially replaced the manual system (App. Ex. 3, Third Allsup Aff'd., ¶36). This demonstrates the superiority of the present invention over prior methods and also the replacement of prior methods by Applicant's new invention. (App. Ex. 3, Third Allsup Aff'd., ¶38).

The continued commercial success of claimed electronic overpayment recovery service is primarily attributable to the fact that (a) direct deposit from SSA to a claimant

account is established for the claimant; (b) the claimant signed preauthorization allows for electronic recovery of a predetermined overpayment amount from the designated account immediately after the direct deposit, but before the recipient takes "mental ownership" of the funds; (c) the service results in an increase in the amount of money recovered; (d) the service decreases the average days to recovery; and (e) the service increases LTD carrier or self-insured employer overpayment recovery rates. (App. Ex. 3, Third Allsup Aff'd., ¶39)

The claimed method has, for the most part, replaced any manual systems. To date, the inventors company has been engaged by sixty-eight (68) companies to perform overpayment recovery services. (App. Ex. 3, Third. Allsup Aff'd. ¶41). It is quite significant that of the sixty-eight (68) companies, sixty-five (65) have opted for the electronic recovery method and only three (3) subscribe to the manual method. (App. Ex. 3, Third. Allsup Aff'd. ¶41). The total dollar amount of overpayments recovered by Allsup since 1999 is more than \$168 million, with the electronic method clients accounting for amounts exceeding \$ 159 million (App. Ex. 3, Third Allsup Aff'd. ¶37).

Furthermore, the recovery service of the present invention has been so successful that since Mr. Allsup's first Affidavit he has determined that at least four competitors in the field are believed to have copied the service. (App. Ex. 3, Third. Allsup Aff'd. ¶42) and client insurance companies are asking competitors to implement the Allsup method. (App. Ex. 3, Third. Allsup Aff'd. ¶42). Copying of the inventor's method by others is objective evidence that the invention is not obvious to one skilled in the art. *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1564,

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7 USPQ2d 1548, 1554 (Fed. Cir. 1988) ("Copying is additional evidence of nonobviousness").

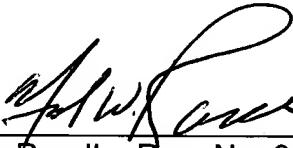
Because the Applicant has produced significant evidence of non-obviousness, Applicant respectfully submits that any inference of obviousness drawn from the cited references is dissipated, and the claims are allowable. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

If for any reason the Examiner feels that an interview would be helpful to resolve any issues, the Examiner is respectfully requested to contact the undersigned attorney for the purpose of arranging such an interview.

Respectfully submitted,

POLSTER, LIEDER, WOODRUFF, & LUCCHESI, L.C.

By


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